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VIA FACSIMILE

June 20, 2007

To: Supervisory Examiner: Wael M. Fahmy      Facsimile No.: 571-273-8300  
Group Art Unit: 2814  
U.S.P.T.O.

From: Scott M. Tulino, Esq.      Facsimile No.: 703-761-2375 or 76

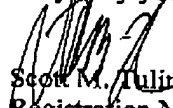
Re: Office Action Dated November 15, 2007  
U.S. Patent Application Serial No.: 10/561,608  
Our Ref. No.: WAK.163

Dear Examiner Fahmy:

Attached herewith is a Petition to Withdraw Finality of the Office Action dated November 15, 2007.

Thank you in advance for your kind consideration on this case.

Very truly yours,

  
Scott M. Tulino, Esq.  
Registration No. 48,317

Sean M. McGinn, Esq.  
Registration No. 34,386

SMT:SMM  
Attachment  
Number of pages (including this cover sheet): 4

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Serial No. 10/561,608 2  
Docket No. NEC04P0102-TOb

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Takashi Ogura, et al.

Serial No.: 10/561,608

Group Art Unit: 2814

Filed: December 20, 2005

Examiner: Hoai V. Pham

For: SEMICONDUCTOR DEVICE AND PRODUCTION METHOD THEREFOR

Honorable Commissioner of Patents  
Alexandria, VA 22313-1450  
Box AF

**PETITION TO WITHDRAW FINALITY**

Sir:

Applicants respectfully submit that the finality of the Office Action dated November 15, 2007 is premature.

In the Office Action dated November 15, 2007 the Examiner alleges, "Applicant's arguments are not persuasive because with recent technological advance with respect to high integration and high speed in semiconductor devices, miniaturization of MISFETs has been under development and the smaller gate length of the MISFET is required. Kubota discloses a gate length of said silicon containing gate electrode being not greater than 0.1  $\mu\text{m}$  (col. 1, lines 18-20). Therefore, it would have been obvious to one of ordinary skill in the art to combine the feature of Kubota with the device disclosed in Wu to reduce the scale of the MISFET device." (See Office Action dated November 15, 2007 at page 7).

In the Amendment filed on August 20, 2007, Applicants argued that the Examiner failed to establish a *prima facie* case of obviousness because the Examiner did not provide any reason why one of ordinary skill in the art would have combined this alleged feature of Kubota with the device disclosed in Wu.

Serial No. 10/561,608 3  
Docket No. NEC04P0102-TOb

In order to establish a *prima facie* case of obviousness "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F. 3d 977, 987, 78 USPQ 2d 1329, 1336 (Fed Cir. 2006)). In other words, in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it is necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

As clearly set forth in the Amendment filed on August 20, 2007, the Examiner did not provide sufficient reasoning (i.e., the Examiner did not provide any reasoning) to establish a *prima facie* case of obviousness.

In the Response to Arguments section of the Office Action dated November 15, 2007 (as quoted above) the Examiner, in response to Applicants' traversal arguments, subsequently provided reasoning for combining the silicon gate thickness disclosed in Kubota with the device of Wu.

Applicants submit, however, that this was the first time the Examiner provided such reasoning. That is, the Examiner's reasoning provided in the Response to Arguments section of the Office Action dated November 15, 2007 was not provided in the Office Action dated April 20, 2007.

Therefore, the Examiner's rejection included in the Office Action dated April 20, 2007 was clearly deficient. Accordingly, since the Examiner did not attempt to obviate the clear deficiency in the rejection until the Office Action dated November 15, 2007, the finality of the Office Action dated November 15, 2007 is clearly premature.

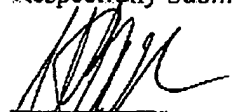
Serial No. 10/561,608 4  
Docket No. NEC04P0102-TOB

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Accordingly, Applicants petition the Patent Office to withdraw the finality of the  
Office Action dated November 15, 2007.

Date: December 13, 2007

Respectfully Submitted,



Scott M. Tulino, Esq.  
Registration No. 48,317

Sean M. McGinn, Esq.  
Registration No. 34,386

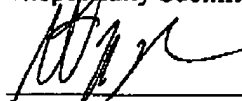
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**FACSIMILE TRANSMISSION**

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2814, at  
(571) 273-8300, on December 13, 2007.

Date: December 13, 2007

Respectfully Submitted,



Scott M. Tulino, Esq.  
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